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APR 7 1999

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Patentees: FODOR

Application No.: 08/670,118, now Patent
No. 5,800,992, granted 09/01/98

Filed: 06/25/96

For: A METHOD OF DETECTING NUCLEIC
ACIDS

Filed by: Judge Fred E. McKelvey

Telephone: (703) 308-9797

Facsimile: (703) 305-0942

The above-identified patent has been forwarded to the Board of Patent Appeals and Interferences because it is adjudged to interfere with another application or patent. An interference has been declared. The interference is designated as No. 104,358.

Notice is hereby given the parties of the requirement of the law for filing in the Patent and Trademark Office a copy of any agreement "in connection with or in contemplation of the termination of the interference." 35 U.S.C. § 135(c).

Fred McKelvey

FRED E. MCKELVEY

Senior Administrative Patent Judge

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FODOR, ET AL

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 1

Filed by: Fred E. McKelvey
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UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

APR 7 1999

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

PATRICK O. BROWN and TIDHAR D. SHALON,

Junior Party,
(Application 08/514,875),

v.

STEPHEN P. A. FODOR, DENNIS W. SOLAS
and WILLIAM J. DOWER,

Senior Party
(Patent 5,800,992).

Patent Interference No. 104,358

NOTICE DECLARING INTERFERENCE
(37 CFR § 1.611)

An interference is declared (35 U.S.C. § 135(a)) between the above-identified parties. Details of the application(s), patent (if any), reissue application (if any), count(s) and claim(s) designated as corresponding or not corresponding to the count(s) appear in an "Attachment" to this NOTICE DECLARING INTERFERENCE.

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1. Judge designated to handle the interference

Senior Administrative Patent Judge Fred E. McKelvey has been designated to handle the interference. 37 CFR § 1.610.

2. Telephone calls to the board

Telephone calls to the board regarding this interference shall be placed to 703-308-9797.

Telephone calls in which counsel wish an administrative patent judge to participate shall be inter partes conference telephone calls in which at least one counsel for each party and the administrative patent judge designated to handle this interference shall participate. There are no exceptions. Any attempt to initiate an ex parte telephone call to an administrative patent judge in connection with this interference may result in sanctions (37 CFR § 1.616; 35 U.S.C. § 32; 37 CFR § 10.23(b)(5); 37 CFR § 10.93).

No attempt shall be made to contact any administrative patent judge not designated to handle this interference without prior permission of an interference administrator (Merrell C. Cashion, Jr.) or the administrative patent judge designated to handle this interference.

Telephone calls requesting a telephone conference call or information of a procedural nature shall be placed to an interference administrator (Merrell C. Cashion, Jr.), a paralegal (Yolunda Townes) or a legal technician (Sonja Despertt), assigned to the Trial Section of the Interference Division of the board. The Trial Section is to handle interlocutory matters in

interferences. A party seeking a conference call with an administrative patent judge should be prepared to advise the interference administrator, paralegal or legal technician why a conference call is believed to be needed.

3. Filing of papers with the board

The parties may file papers with the board in any of the following manners:

a. Hand-delivery to the Office of the Clerk between the hours of 8:30 a.m. and 5:00 p.m. at:

Board of Patent Appeals and Interferences
Crystal Gateway 2
10th Floor
1225 Jefferson-Davis Highway
Arlington, VA 22202.

Any paper hand-delivered to the Office of the Clerk before 10:00 a.m. is deemed to have been filed the previous business day provided the paper was properly served the previous business day.¹

b. Commercial overnight delivery service, addressed as follows:

Board of Patent Appeals and Interferences
Crystal Gateway 2
10th Floor
1225 Jefferson-Davis Highway
Arlington, VA 22202.

¹ The ability to file a paper in the Office of the Clerk by 10:00 a.m. is designed to eliminate any need to hand-deliver papers with the PTO Mail Room after business hours.

Papers filed by a commercial overnight delivery service will be deemed filed on the date they are delivered to the commercial overnight delivery service.

c. Delivery to the PTO Mail Room or by U.S. Postal Service, including Express Mail, addressed as follows:

BOX INTERFERENCE
Commissioner of Patents and Trademarks
Washington, D.C. 20231.

d. Facsimile (703-305-0942).

Papers exceeding five (5) pages in length cannot be filed by facsimile without prior permission of an interference

administrator. A confirmation copy is not needed when filing a paper by facsimile.

Hand-delivery to the Office of the Clerk of the Board will minimize the time it takes to (1) process the paper and (2) decide any request made in the paper..

4. Use of cover sheet in filing papers in interference cases with the board

All papers filed with the board in connection with this interference shall have a pink cover sheet similar to the pink cover sheet accompanying this NOTICE DECLARING INTERFERENCE.

5. Requirement for filing two copies of each paper

When presenting a paper in this interference, each party is required to submit (1) an original and (2) one copy of each paper, the copy shall be marked at the top:

"COPY FOR JUDGE"

6. Notice under 35 U.S.C. § 135(c)

Notice is hereby given of the requirement of 35 U.S.C. § 135(c) for filing in the PTO a copy of any agreement "in connection with or in contemplation of the termination of the interference." See Unisys Corp. v. Commissioner of Patents and Trademarks, 39 USPQ2d 1842 (D.D.C. 1993). The date an interference terminates is set out in 37 CFR § 1.661.

7. Lead and backup counsel

Within **fourteen (14)** days of the date of this NOTICE DECLARING INTERFERENCE, each party is required to identify in a separate paper

- a. a lead counsel (37 CFR § 1.613(a));
- b. a backup lead counsel;
- c. a mailing address;
- d. in the event the mailing address is a Post Office Box, an address where overnight packages may be delivered;
- e. telephone number;
- f. facsimile number and
- g. internet e-mail address, if available.

If lead counsel and/or backup counsel are not counsel of record (37 CFR § 1.34(b)) in the application or patent involved in this interference, then within **fourteen (14) days** of the date of this NOTICE DECLARING INTERFERENCE, an appropriate power of attorney shall be filed.

8. Real party in interest

Within **fourteen (14) days** of the date of this NOTICE DECLARING INTERFERENCE, each party shall notify the board in a separate paper of any and all right, title, and interest in any application or patent involved in the interference (37 CFR § 1.602(b)).

All parties are obligated to continually and promptly update changes of the real party in interest.

9. Request for copies of files

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The parties to the interference have access to the patent and application files involved in the interference, as well as any benefit files identified in this order. 37 CFR § 1.612(a). The parties are advised that the interference file does not include any involved application, patent or benefit files, all of which are maintained separate from the interference file. Within **fourteen (14) days** of the date of this order, each party shall file **with the board** (not another office in the Patent and Trademark Office) a separate paper requesting copies of those files identified in this order which that party would like to obtain. The request must include:

- a. a list by patent number and application number of the files desired,
- b. a Patent and Trademark Office Deposit Account to which fees may be charged for making copies, and

- c. a complete street, city and state address (not a P.O. Box) of the location where copies are to be shipped.

The parties are encouraged to file requests for copies by facsimile. Within **twenty-one (21) days** of the date of this notice, the board will forward all requests timely received and all necessary files to the Office of Public Records (OPR) for copies to be made and shipped via overnight delivery service. OPR has advised the board that copies will be made and shipped within **fourteen (14) days** of receipt of the request and files.

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The parties are advised that from (1) the date of this order until (2) the date files are returned by OPR to the board, the files may be inspected only at the Office of the Clerk of the Board. The files will not be released to any individual outside the board for any purpose until the board receives the files from OPR (which will occur following shipment of copies). Hence, the files cannot be inspected while at OPR.

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The parties are further advised that failure to timely request copies of files will under no circumstances constitute a basis for granting an extension of time (37 CFR § 1.645(a)).

The parties are requested to file a facsimile upon receipt of any files which were ordered. The facsimile will allow the board to monitor receipt of files requested by parties.

10. Size of paper²

With the possible exception of original exhibits of a different size, all papers (e.g., identification of lead counsel, identification of real party in interest, motions, preliminary motions, preliminary statements, copies of deposition transcripts, briefs, etc.) filed in this interference shall be

- a. 8½ x 11 inch paper or
- b. A4.

11. Holes at the top of papers³

All papers filed in this interference shall have two holes punched at the top spaced at 2-3/4 inches apart (each hole spaced equidistant from an imaginary center line running from the top to the bottom of the paper) so that the papers may be placed in interference files maintained by the PTO.

² The purpose of this requirement is to facilitate storage of papers, files and evidence at the board.

³ The purpose of this requirement is to facilitate placing papers in files and to avoid the need to unstaple papers, thereby minimizing the chance that a page of a particular paper will be misplaced.

12. Prohibition against presenting duplicate papers⁴

When presenting a paper in this interference, a party shall not submit with the paper (as an appendix, exhibit, or otherwise) a copy of a paper previously filed in the interference (37 CFR § 1.618(b)).

13. Prohibition against incorporation by reference of arguments made in another paper⁵

Arguments presented in one paper shall not be incorporated by reference to another paper.

14. Citation of case law in papers

When citing a decision of a court which is published in the West Reporter System and the USPQ, counsel should provide parallel citations, e.g., Aelony v. Arni, 547 F.2d 566, 192 USPQ 486 (CCPA 1977); In re Deckler, 977 F.2d 1449, 24 USPQ2d 1448 (Fed. Cir. 1992).

Binding precedent is the following:

- a. Decisions of the U.S. Supreme Court.
- b. Decisions of the Court of Appeals for the Federal Circuit, the former CCPA and the former Court of Claims. See South Corp. v. United States, 690 F.2d 1368, 1370-71, 215 USPQ 657, 657-58 (Fed. Cir. 1982) (en banc), and In re Gosteli,

⁴ The purpose of this requirement is to minimize the size of files and facilitate storage of material in the limited storage space available to the board.

⁵ The purpose of this requirement is to minimize the chance that an argument will be overlooked and to maximize the efficiency of the decision-making process.

872 F.2d 1008, 1011, 10 USPQ2d 1614, 1616-17 (Fed. Cir. 1989) (where there is a conflict between two or more decisions of the former CCPA, the later CCPA decision controls).

c. Decisions of the Commissioner of Patents and Trademarks.

d. Decisions of the Board of Patent Appeals and Interferences which have been determined to be binding precedent under the board's Standard Operating Procedure 2. See, e.g., Reitz v. Inoue, 39 USPQ2d 1838 (Bd. Pat. App. & Int. 1995).

Decisions of the regional courts of appeals and the district courts may be cited, but are not binding precedent.

Non-precedential decisions of federal courts shall not be cited.

Non-precedential decisions of the board may be cited, but are not binding.

The Manual of Patent Examining Procedure (MPEP) (7th ed. July 1998) is a guide for patent examiners which is prepared by the Office of the Assistant Commissioner for Patents. The MPEP contains Chapter 2300 on interference practice. Generally,

Chapter 2300 of the MPEP should not be cited in papers filed in this interference. Rather, counsel should instead cite only primary authority: the United States Code (USC), the Code of Federal Regulations (CFR), notices published in the Federal Register and/or Official Gazette, and binding precedent.

15. Copies of precedent relied upon

The parties are encouraged to submit with papers copies of court opinions and statutes relied upon for use by board personnel--the copies of court opinions and statutes will not become part of the record. The parties are required to submit with the document in which a court opinion is cited a copy of any opinion which is not reported in West Publishing Company's Supreme Court Reporter, the F.2d, or the F.3d and the USPQ or USPQ2d.

16. Service of papers by hand or Express Mail⁶

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All papers served on opposing counsel in this interference shall be served by Express Mail (an overnight one-day delivery service of the U.S. Postal Service) (37 CFR § 1.646(d)); alternatively counsel may serve opposing counsel using any means which accomplishes an overnight one-day delivery, e.g., by hand, facsimile, or a commercial overnight delivery service.

The day a facsimile is transmitted, an overnight package is delivered to a courier or a paper is served by hand does not count in the calculating of the time for filing a response.

17. Conference call to set dates

A telephone conference call to set dates for action in this interference will not be set at this time. A conference call to set dates to taking action during the preliminary motion phase of

⁶ The purpose of this requirement is to place all parties on a level playing field by avoiding different delivery times which inherently occur through the use of the U.S. Postal Service.

the interference will be scheduled following proceedings under 37 CFR § 1.608(b) and 37 CFR § 1.617.

18. Headings to be used on papers in the interference⁷

In papers filed with the board by party in this interference, the heading shown in the attached Appendix shall be used.

19. Copies of patents and literature mentioned in each specification (and translations, if available)⁸

Within one (1) month of the date of this order, each party:

- a. shall serve on all opponents a legible copy of every patent, literature reference and test standard (i.e., an ASTM test), and in the case of patents, literature or test standards in a foreign language, a translation, if available, mentioned in the specification of the party's involved patent and/or application upon which the party will rely for benefit, and
- b. shall file with the board a notice (without copies of the patents or literature) that it has served the patents and literature as ordered herein.

⁷ The purpose of this requirement is to standardize headings, to be able to immediately recognize which party is filing the paper and to facilitate calls by the staff of the board in the event correction is needed.

⁸ The purpose of the additional discovery ordered by this requirement is to place the parties on a level playing field. A party should have access to documents cited in its specification and it may be difficult for an opponent to locate those documents. 37 CFR § 1.687(c).

Upon a future request by the board, the parties should be prepared to promptly file copies of the patent, literature references and/or test standards.

20. Clean copy of claims⁹

Within **fourteen (14) days** of the date of this order, each party shall file **two (2) copies** of a clean set of all claims (as they exist as of the date of the declaration of this interference)

- a. pending in the party's involved application or
- b. contained in the party's involved patent

(including any changes which took place by way of a certificate of correction after granting of the patent and before declaration of the interference).

If the claims refer to a sequence, a copy of the sequence shall be included along with the clean copy of the claims.

21. Application or patent with a drawing and/or claims containing means or step for performing a specified function limitations¹⁰

If any involved patent or application contains:

- (1) a drawing and/or
- (2) a claim designated as corresponding to a count reciting a means or step for performing a

⁹ The purpose of this requirement is to have readily available a clean copy of the claims of the parties. In applications, claims are often spread throughout the file. In patents, there are often certificates of correction.

¹⁰ The purpose of this requirement is to allow all parties and the board to understand the precise scope of the claims which correspond to the count. Also, since a count may itself refer to a claim which contains a means or step for performing a specified function, the requirement will also make it easier to understand the scope of a count.

specified function (35 U.S.C. § 112, sixth paragraph),
then within **twenty-eight (28) days** of the date of this order, the party is required to file (in addition to the paper required by paragraph 20 of this order) a separate paper containing a copy of the claims in which:

- (a) following each element recited in each claim, the drawing numbers corresponding to that element are inserted in braces { }¹¹ and in bold and
- (b) following each means or step for performing a specified function are inserted in braces { }, and in bold, all structure, material or acts described in the specification corresponding to that means or step (by references to the page(s) and line(s) of the specification and/or figure and item number of the drawings).

An example follows:

An apparatus comprising
a pump { **Fig. 1, item 18** },
a body member { **Fig. 1, item 19** },
a first valve { **Fig. 2, item 25** },
means for calculating a numerical value for an
exponent { **page 2, lines 8-10; page 4, lines 21-25;**
Fig. 2, item 34 },

¹¹ Braces { } are required instead of brackets [] because brackets are used in claims in reissue applications.

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means for printing { page 5, line 8 through
page 6, line 1; Fig. 3, items 45 and 46 }, and
a second valve { Fig. 3, item 98 } ***.

If during the prosecution of the interference, a party presents (1) a new or amended claim in an application which contains a drawing and/or (2) a new or amended claim which recites a means or step for performing a specified function, the party shall (in addition to all other requirements of the rules) file a separate paper containing a copy of the new or amended claim complying with the requirements set out above.

If during the prosecution of the interference, a party files a preliminary motion seeking the benefit of an earlier application (1) containing a drawing or (2) with respect to a claim in an involved patent or application which recites a means or step for performing a specified function, the party shall (in addition to all other requirements of the rules) file an appendix to the preliminary motion containing a copy of the claims complying with the requirements set out above.

If during the course of this interference, a party intends to argue that a structure, material or act is an equivalent (within the meaning of 35 U.S.C. § 112, sixth paragraph) of a structure, material or act described in the specification, then the party shall:

- a. promptly file a notice¹² with the board of its intention to argue the equivalency;
- b. clearly set out the precise nature of the structure, material or act which is deemed to be equivalent to the structure, material or act described in the specification and
- c. bear the burden of proof of establishing the equivalency alleged.

22. Copy of papers in electronic and/or CD-ROM form¹³

At an appropriate time in the interference, and in addition to papers required to be filed by the rules or an order of the board, the parties are authorized to file either or both of (1) a 100mb ZIP® disk for a ZIP® disk drive and/or a CD-ROM¹⁴ (for use

¹² In the case of a preliminary motion, notice is deemed to be promptly given if it is given in the preliminary motion or, if raised by an opponent, in an opposition to a preliminary motion. In the case of priority, notice is deemed to be promptly given if a separate paper is filed with the board at the same time a party serves its case-in-chief.

¹³ The purpose of this paragraph is to put the parties on notice that they are authorized to file documents in electronic or CD-ROM form. Often documents in electronic or CD-ROM form are more easily searched and can minimize the chance that an argument or evidence will be overlooked.

¹⁴ Filing a CD-ROM would be subject to the following conditions:

1. The CD-ROM must be capable of operating on a computer with 486 or higher running on Windows 95 and Windows NT.
2. The board has monitor capability of 256 colors and an 800 x 600 screen setting.
3. The CD-ROM would have to be equipped with software that can be loaded onto the PTO computer and must be accompanied by instructions for its use.
4. Any party wishing to file the brief on CD-ROM must provide four (4) copies of the CD-ROM to the board.
5. One copy of the CD-ROM must be served on all opponents.
6. In addition, the required number of paper copies must also be filed in the PTO and served on all opponents.

in an IBM compatible computer) containing any or all of the following documents:

- a. the specification,
- b. the claims,
- c. any motion, opposition or reply,
- d. affidavit¹⁵ testimony,
- e. exhibits,
- f. transcripts of cross-examination,
- g. principal, opposition and reply briefs at final hearing and
- h. other material, such as statutes, rules and court and administrative precedent relied upon in preliminary motions, principal briefs, oppositions and/or replies.

23. Time to respond to miscellaneous motions under 37 CFR § 1.635

There are three kinds of motions which can be filed in an interference:

- a. A preliminary motion under 37 CFR § 1.633.
- b. A motion to correct inventorship under 37 CFR § 1.634.
- c. A miscellaneous motion under 37 CFR § 1.635.

The time for filing an opposition to a miscellaneous motion under 37 CFR § 1.635 is hereby set to be **five (5) working days** after service of the motion. 37 CFR § 1.638(a).

¹⁵ Affidavit includes a declaration. 37 CFR § 1.601(b).

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The time for filing a reply to an opposition to a miscellaneous motion under 37 CFR § 1.635 is hereby set to be **three (3) working days** after service of the opposition. 37 CFR § 1.638(b).

A motion under 37 CFR § 1.635 may be denied prior to receipt of an opposition. A motion under 37 CFR § 1.635 may be granted after an opposition is filed and prior to receipt of a reply.

24. Requests under 37 CFR § 1.642 to add an application or patent

A request pursuant to 37 CFR § 1.642 to add an application or patent to an interference shall be made in the form of a miscellaneous motion under 37 CFR § 1.635. Any motion should:

- a. identify the additional application or patent to be added;
- b. certify that a complete copy of the file wrapper of application has been served on all opponents; and
- c. explain which claims of the patent or application should be designated as corresponding to the count.

25. Manner of styling motions¹⁶

The style of all motions shall appear on a single line, shall be free of the words "et al".

¹⁶ The purpose of this requirement is to simplify docket entries at the board.

Any motion shall be consecutively numbered starting with number 1.

Any opposition shall bear the same number as the motion it opposes.

Any reply shall bear the same number as the opposition to which it replies.

In a second line, a party may specify the nature of the motion. Examples of how motions, opposition and replies should be styled follows.

- a. Jones Miscellaneous Motion 1
(for additional discovery)
- b. Jones Preliminary Motion 2
(for judgment based on prior art)
- c. Jones Preliminary Motion 3
(for judgment based on lack of enablement)
- d. Jones Motion to Correct Inventorship 4
- e. Smith opposition 2
(To Jones preliminary motion 2)
- f. Smith opposition 4
(To Jones motion to correct inventorship 4)
- g. Jones reply 2
(To Smith opposition 2)

26. Manner of presenting motions, oppositions and replies¹⁷

- a. In presenting a motion, a party shall set out in the following order:

¹⁷ The purpose of these requirements is to facilitate consideration of motions, to minimize the chance that an argument will be overlooked and to make it easier to determine whether a reply raises new issues.

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- (1) The precise relief requested (two examples are (a) Jones moves to be accorded the benefit of the filing date of application 07/999,999, filed January 22, 1993 or (b) Jones moves for judgment against Smith on the ground that Smith's claims 1, 2 and 5 corresponding to the count are unpatentable under 35 U.S.C. § 103 over the combined disclosures of U.S. Patent No. 4,444,444 (Johnson) and French Patent 1,111,111 (Boleau)).
 - (2) The evidence (i.e., a list of all exhibits by number) the moving party relies in support of the motion.
 - (3) The facts in separately numbered paragraphs with a citation to the evidence.
 - (4) The reasons why relief should be granted.
- b. In presenting an opposition, a party shall set out in the following order:
- (1) The evidence (i.e., a list of all exhibits by number) the opposing party relies in support of the opposition.
 - (2) Whether each fact alleged by the moving party is admitted, denied or that the opposing party is unable to admit or deny the fact alleged.

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(3) Any additional facts upon which the opposing party intends to rely with a citation to the evidence.

(4) the reason why relief is opposed in the following manner: "On page x, lines y-z of the motion, it is argued that _____. The response is _____."

c. In presenting a reply, a party shall set out in the following order:

(1) The evidence relied upon (i.e., a list of all exhibits by number) the moving party relies in support of the reply.

(2) Whether each additional fact alleged by the opposing party is admitted, denied or that the moving party is unable to admit or deny the fact alleged.

(3) Any additional facts upon which the moving party intends to rely to rebut additional facts alleged by the opposing party with a citation to the evidence.

(4) The argument responsive to statements in the opposition in the following manner: "On page x, lines y-z of the opposition, it is argued that _____. The response is _____."

d. When anticipation (35 U.S.C. § 102) over a single prior art reference is the basis for a preliminary motion for judgment (37 CFR § 1.633(a)), each claim alleged to be anticipated should be reproduced as an appendix to the preliminary motion. Following each element recited in each claim, and within braces { }¹⁸ and in bold, there shall be inserted a specific reference to the column and line and/or drawing figure and numeral and/or other material where the reference describes each element of the claim. A similar procedure should be used for each claim of an opponent which a party maintains is anticipated.

e. When obviousness (i.e., 35 U.S.C. § 103) over the prior art is the basis for a preliminary motion for judgment (37 CFR § 1.633(a)), a similar procedure shall be used [at least one element of the claim will not be described in a prior art reference]. Any difference shall be explicitly identified. Finally, an explanation should be made as to why the subject matter of the claim, as a whole, would have been obvious to a person having ordinary skill in the art notwithstanding any difference. A similar procedure should be used for each claim of an opponent which a party maintains is unpatentable based on obviousness.

¹⁸ Braces { } are required instead of brackets [] because brackets are used in claims in reissue applications.

27. Order accompanying motions¹⁹

Each motion and opposition shall be accompanied by **two (2) copies** of a proposed order suitable for entry by the administrative patent judge. The form of the order should be as follows: "Upon consideration of Jones Miscellaneous Motion 4 and Smith opposition 5 thereto, it is ordered that the motion is granted (or denied)."

The last page of the proposed order shall contain a list of the counsel, their addresses and facsimile numbers to which the order shall be sent.

28. Page number limitation on motions, oppositions and replies

A motion is limited to twenty-five (25) pages, not including any certificate of service.

An opposition to a motion is limited to twenty-five (25) pages, not including any certificate of service.

A reply to an opposition is limited to ten (10) pages, not including any certificate of service.

29. Use of double space typing

All typing in papers (including quotes and footnotes, but excluding headings, signature blocks and certificates of service) shall be double spaced. The use of footnotes is discouraged.

¹⁹ The purpose of this requirement is to permit motions to be decided and communicated as promptly as possible, particularly those which do not require an opinion.

30. "Combined" oppositions and replies not to be filed

An opposition shall respond to only a single motion; "combined" oppositions responding to more than one motion shall not be filed.

A reply shall respond to only a single opposition;
"combined" replies to more than one opposition shall not be
filed.

31. No new issues to be raised in replies

As provided by the rules, no new issues are to be raised in replies.

A new issue will be deemed to be raised in a reply if the reply refers to new evidence which is necessary to make out a prima facie case for the relief requested in, and/or which could have been included with, the motion.

A reply which is longer than a motion or an opposition probably raises new issues.

If a reply raises any new issue or belatedly relies upon evidence which should have been earlier presented, **the entire reply and belatedly relied upon evidence will not be considered.**

The board will not attempt to sort out legitimate reply from improper reply.

32. Conference call prior to filing contested Rule 635 motion

Prior to filing a miscellaneous motion under 37 CFR § 1.635,
a party shall:

- a. confer with all opponents as required by 37 CFR § 1.637(b) and, if agreement cannot be reached,
- b. place a conference call to the administrative patent judge designated to handle this interference.

A motion for a clarification of the procedure to be used in this interference shall not be filed until a conference call has been placed to the administrative patent judge designated to handle this interference.

The parties, at their expense, may--and are encouraged to--retain the services of a court reporter to record the telephone conference call. A court reporter is often desirable inasmuch as an oral decision may be made with respect to issues raised during the conference call.

33. Time for objection to admissibility of evidence

Any objection to the admissibility of evidence, including evidence filed with any motion, opposition or reply shall be filed within **five (5) working days** of service of the evidence to which the objection is made, including evidence presented in connection with a preliminary motion.

34. Time for serving supplemental affidavits

Any supplemental affidavit to respond to any objection to the admissibility of evidence shall be served (but not filed) within **two (2) weeks** of the date an objection was served.

35. Time for cross-examination

Cross-examination of any affiant may begin no earlier than **twenty-one (21) days**²⁰ after service of an affidavit.

Cross-examination of an affiant relied upon in a preliminary motion shall take place before an opposition to the preliminary motion is filed.

Cross-examination of an affiant relied upon in an opposition to a preliminary motion shall take place before a reply is filed.

36. Order of cross-examination

The party asking for cross-examination, upon reasonable notice, shall have the right to select the order in which cross-examination occurs when more than one witness is to be cross-examined.

37. Reliance on a paper in a patent or application file

The specification and drawings of any involved or benefit application are evidence in an interference. 37 CFR § 1.671(a). Nevertheless, if a motion relies on a paper in the file of an involved or benefit patent and/or application (including a specification and/or drawings) involved in the interference, a copy of the paper shall be made an exhibit in the interference.

²⁰ The twenty-one (21) day period is sufficient to allow for objections to the admissibility of evidence and the filing of supplemental affidavits.

38. Affidavits in file wrappers not evidence

Affidavits, such as Rule 131 and Rule 132 affidavits, presented during ex parte prosecution of an involved and benefit application or patent are not evidence in an interference. If a party seeks to have such an affidavit considered, the party must place the affidavit in evidence as an exhibit. Any opponent will have an opportunity to object to the admissibility of the evidence and to cross-examine. A party submitting the evidence will have an opportunity to supplement the evidence following a timely objection by an opponent.

39. Manner of labelling exhibits²¹

Exhibits used by a party in this interference shall be assigned consecutive numbers throughout the course of the interference.

Exhibits should be identified by an exhibit number (not letters) on a label placed in the lower right-hand corner of the first page of the exhibit. Compare 37 CFR § 1.653(i).

If important material is covered by an exhibit label on the first page of the exhibit, a copy of the first page of the exhibit may be reproduced and presented as page 1-a of the exhibit.

²¹ The purpose of this requirement is to maximize the chance that any misplaced exhibit can be associated with the proper interference and to facilitate identification during deliberations as to who filed an exhibit.

Exhibits should be labeled, e.g., as follows:

Jones EXHIBIT 1001
Jones v. Smith
Interference 108,111

Smith EXHIBIT 2001
Jones v. Smith
Interference 108,111

Affidavits relied upon during the course of the interference shall be assigned an exhibit number.

The party currently designated as junior party shall consecutively number exhibits beginning with Exhibit 1001.

The party currently designated as senior party shall consecutively number exhibits beginning with Exhibit 2001.

At the conclusion of the preliminary motion period and at the time the record on the issue of priority is filed, the parties should plan on submitting all original exhibits, including affidavits, in an accordion folder, box or other folder containing all exhibits in numerical order, the idea being that each motion, opposition, reply, affidavit or transcript of cross-examination shall refer to the exhibit by number.

The filing of multiple copies of the same exhibit with different exhibit numbers is not authorized.

40. Exhibit list

Each party shall maintain an exhibit list. The list shall contain the exhibit number and a brief description thereof. Upon request by the board, the party should be prepared to file a copy of the exhibit list.

41. Specification as evidence

A specification of an application or patent involved in the interference is admissible as evidence only to prove what the specification or patent describes. If there is data in the specification upon which a party intends to rely to prove the truth of the data, an affidavit by an individual having first-hand knowledge of how the data was generated (i.e., the individual who performed an experiment reported as an example in the specification) must be filed.

The individual will be subject to cross-examination.

42. Affidavits of expert witnesses

Affidavits expressing an opinion of an expert must disclose the underlying facts or data upon which the opinion is based.

See Fed. R. Evid. 705 and 37 CFR §§ 1.639(b) and 1.671(b).

Opinions expressed without disclosing the underlying facts or data may be given little, or no, weight. See Rohm and Haas Co. v. Brotech Corp., 127 F.3d 1089, 1092, 44 USPQ2d 1459, 1462 (Fed. Cir. 1997) (nothing in the Federal Rules of Evidence or Federal Circuit jurisprudence requires the fact finder to credit the unsupported assertions of an expert witness).

43. Reliance on scientific tests and data

Parties often rely on scientific tests and data, both in the preliminary motion phase and during the priority testimony phase. Examples include IR (infra-red) and graphs generated therefrom, HPLC (high performance liquid chromatography) and data generated

therefrom, etc. In the event a party relies on a scientific test or data generated from a scientific test, the party relying on the test or data shall explain:

- a. the reason why the test is being used and why the data is being relied upon;
- b. how the test is performed;
- c. how the data is generated using the test;
- d. how the data is used to determine a value;
- e. the acknowledged accuracy of the test; and
- f. any other information which the party believes would aid the board in understanding the significance of the test and/or data.

The explanation desirably takes place through an affidavit testimony of a witness, preferably accompanied by references to relevant pages of standard texts (which should be exhibits in the interference).

44. Letters between counsel not to be filed

Unless a letter between counsel is made an exhibit to a motion, opposition, reply, affidavit or during cross-examination, no letters between counsel are to be filed with the board.

45. Requirement for settlement negotiations²²

The parties are encouraged to attempt to settle this interference. Accordingly, within **three (3) months** of the date of this NOTICE DECLARING INTERFERENCE, the parties are required to conduct a settlement conference and discuss settlement possibilities. The senior party shall be responsible for initiating any settlement discussions. The administrative patent judge designated to handle this interference may be contacted via telephone conference call to render any assistance which might accomplish settlement.

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100720:87702980
Within **three (3) months** of the date of this NOTICE DECLARING INTERFERENCE, the parties are required to initiate a telephone conference call with the administrative patent judge designated to handle this interference and should be prepared to discuss at that time:

- a. report on the outcome of the settlement conference;
- b. whether the parties are actively engaged in settlement negotiations and, if so, what steps have already been taken toward settlement;

²² The purpose of this paragraph is to facilitate settlement discussions. To eliminate any possibility that initiation of settlement discussions might be construed as a weakness on the party initiating settlement discussions, the senior party shall be responsible for initiating any settlement discussions, for initially drafting any document or for initiating any conference call required by this paragraph.

- c. whether any settlement negotiations are directed toward resolving prior inventorship and obviating the need for filing preliminary motions;
- d. identify any issues which are not subject to settlement negotiations; and
- e. the status of any settlement negotiations, including how much time might be needed to conclude those negotiations.

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Unless a different time is set in an order establishing a testimony period, within **two (2) months** after a decision on preliminary motions, the parties are further required to conduct a settlement conference and discuss settlement possibilities. Within the same time period, the parties are also required to initiate another telephone conference call with the administrative patent judge designated to handle this interference and should be prepared to discuss at that time the items set out in paragraph a through e, supra.

Unless a different time is set in an order establishing a testimony period, within **one (1) month** after service of the record, the parties are still further required to conduct a settlement conference and discuss settlement possibilities. Within the same time period, the parties also are required to initiate another telephone conference call with the administrative patent judge designated to handle this interference and should be prepared to discuss at that time the items set out in paragraph a through e, supra.

Prior to initiating any conference call required by this paragraph, the parties are required to file (preferably by facsimile) a joint statement indicating that a good faith effort has been made to settle this interference.

46. Guidelines for cross-examination

Cross-examination is a useful tool for determining the facts in a case. In interference cases, testimony is initially presented by affidavit. 37 CFR § 1.639(b); 37 CFR § 1.672(b) and (c). Cross-examination occurs by oral deposition. 37 CFR § 1.672(d). With respect to the cross-examination depositions, the guidelines of Hon. Robert S. Gawthrop, III, U.S. District Judge, essentially as set out in his opinion in Hall v. Clifton Precision, a division of Litton Systems, Inc., 150 F.R.D. 525 (E.D. Pa. 1993), shall apply as hereinafter discussed. There is only one basic exception and that exception is due to PTO rules. Objections must be noted on the record. See 37 CFR § 1.675(c).

As Judge Gawthrop notes, a deposition is meant to be a question-and-answer conversation between the deposing lawyer and the witness. There is no proper need for the witness's own lawyer to act as an intermediary, interpreting questions, deciding which questions the witness should answer, and helping the witness to formulate answers. The witness comes to the deposition to be questioned on cross-examination. It is the witness, and not the lawyer, who is the witness.

In view of the above, and pursuant to 37 CFR § 1.610(e), the following guidelines shall apply.

Guideline [1]

At the beginning of the deposition, deposing counsel taking cross-examination shall instruct the witness on the record to ask deposing counsel, rather than the witness's own counsel, for clarifications, definitions or explanations of any words, questions or documents presented during the course of the deposition. The witness shall abide by the instructions.

Guideline [2]

Counsel shall not direct or request that a witness not answer a question, unless:

(1) counsel has objected to the question on the ground that the answer would:

(a) reveal privileged material or

(b) violate a limitation imposed by an administrative patent judge or a panel of the Board of Patent Appeals and Interferences and

(2) counsel immediately places a telephone conference call to the administrative patent judge designated to handle this interference asking orally for a ruling on the objection.

Under these circumstances, (1) the deposition shall be suspended, (2) the telephone conference call immediately shall be placed to the administrative patent judge designated to handle this interference, and (3) all counsel must be prepared to address orally their respective positions. The court reporter in attendance at the deposition shall be available to record any

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telephone discussion and to read back questions to which an objection has been made.

If an administrative patent judge cannot be reached, then the party directing a witness not to answer shall, within **two (2) working days**, hand deliver to the Board (Crystal Gateway 2, 10th Floor, 1225 Jefferson Davis Highway, Arlington, Virginia), and not to the PTO Mail Room or any other PTO office, a motion under 37 CFR § 1.635 seeking relief. Any opposition must be hand delivered to the Board within **two (2) working days**. While a reply can be filed, counsel should assume that the motion is under advisement and can be decided at any time upon (a) receipt of an opposition, or (b) failing timely hand delivery of an opposition, then immediately.

Guideline [3]

Counsel shall not make objections or statements which might suggest an answer to a witness. Any objection to evidence during a deposition shall be stated concisely and in a non-argumentative and non-suggestive manner. Opposing counsel should not address the correctness of an objection. Rather, opposing counsel should continue with questions to the witness, the objection having been noted on the record as required by 37 CFR § 1.675(c).

With respect to this guideline, the following observation by Judge Gawthrop should be noted:

I also note that a favorite objection or interjection of lawyers is, "I don't understand the question; therefore the witness doesn't understand the

question." This is not a proper objection. If the witness needs clarification, the witness may ask the deposing lawyer for clarification. A lawyer's purported lack of understanding is not a proper reason to interrupt a deposition. In addition, counsel are not permitted to state on the record their interpretations of questions, since those interpretations are irrelevant and often suggestive of a particularly desired answer.

By way of example, the following comments by counsel not conducting cross-examination generally are viewed as suggesting an answer to a witness:

1. Objection, vague.
2. Objection, to the form of the question.
3. Take your time in answering the question.
4. Look at the document before you answer.
5. Counsel, do you want to show him/her the document?

Guideline [4]

Counsel and their witness-clients shall not engage in private, off-the-record conferences during depositions or during breaks or recesses, except for the purpose of deciding whether to assert a privilege. The term "witness-clients" in the context of this guideline and patent interference practice includes all witnesses who are employed by, or otherwise under the control of, the real party in interest in the interference, including

retained expert witnesses, as well as the individual or individuals named in the caption of the interference.

With respect to this guideline, the following observation by Judge Gawthrop should be noted:

The fact that there is no [administrative patent] judge in the room to prevent private conferences does not mean that such conferences should or may occur. The underlying reason for preventing private conferences is still present: they tend, at the very least, to give the appearance of obstructing the truth.

Guideline [5]

Any conferences which occur pursuant to, or in violation of, guideline [4] are a proper subject for inquiry by deposing counsel to ascertain whether there has been any witness-coaching and, if so, what.

Guideline [6]

Any conferences which occur pursuant to, or in violation of, guideline [4] shall be noted on the record by the counsel who participated in the conference. The purpose and outcome of the conference shall also be noted on the record.

Guideline [7]

Deposing counsel taking cross-examination shall provide to the witness's counsel a copy of all documents shown to the witness during the deposition. The copies shall be provided either before the deposition begins or contemporaneously with the showing of each document to the witness. The witness and the

witness's counsel do not have a right to discuss documents privately before the witness answers questions about the documents.

Failure to adhere strictly to these guidelines may be a basis for a sanction under 37 CFR § 1.616, which could include a requirement that the witness, on very short notice (i.e., the next day including if appropriate a non-work day) may be directed to appear before the board in Arlington, Virginia or elsewhere as may be appropriate, coupled with any appropriate award of compensatory damages under Rule 616. In addition, cross-examination undertaken contrary to these guidelines may result in exclusion of an affidavit from evidence or little, if any weight, being given to the direct testimony of a witness who was cross-examined.

47. Comments on requests for extensions of time

The parties are advised that times have been set with the view to rendering prompt and timely decisions. Thus, in setting times in this interference, also taken into account are times set in other interference and decisions which need to be rendered in this interference, as well as other interference.

It is true that requests for extension of time are authorized by 37 CFR § 1.645. But, Rule 645 requires a showing of "good cause." Whatever counsel's experience may be in other PTO matters, prior interferences or courts generally, the standard of what constitutes "good cause" within the meaning of Rule 645 is considerably high.

There are few, if any, circumstances where "good cause" can be based on the press of other business arising after a time is set by an order entered in this interference, particularly where a time period is set after conference with counsel. Thus, a matter in another case (i.e., argument or a trial) or an event (i.e., a deposition, client meeting in the U.S. or abroad) scheduled or ordered after a conference call, in which a time is set in this interference, normally will not constitute the press of other business.

Generally, an attempt to settle is not "good cause." While settlement is encouraged, and the administrative patent judge designated to handle this interference is available to assist in settlement efforts where appropriate, the parties should expect to either settle interference or, in the absence of settlement, to meet the next pending deadline.

Fred McKelvey

FRED E. McKELVEY
Senior Administrative Patent Judge

7 April 1999
Arlington, VA

Attachment
(37 CFR § 1.611(c))

The parties involved in this interference are:

Junior Party

Named inventors: Patrick O. Brown, Stanford, CA
Tidhar D. Shalon, Atherton, CA

Application: Application 08/514,875,
filed 14 August 1995

Title: Method for analyzing gene expression patterns

Assignee: None

Attorneys: See last page

Accorded Benefit: None

Address: See last page

08570449-071001

Senior Party

Named Inventors: Stephen P. A. Fodor, Palo Alto, CA
Dennis W. Solas, San Francisco, CA
William J. Dower, Menlo Park, CA

Patent: U.S. Patent 5,800,992,
issued 1 September 1998,
based on application 08/670,118,
filed June 25, 1996

Title: Method for detecting nucleic acids

Assignee: Affymetrix, Inc.²³

Attorneys: See last page

Accorded Benefit: Application 08/168,904,
filed 15 December 1993

Application 07/624,114,
filed 6 December 1990

Address: See last page

08670418-071001
FOOTNOTES

²³ Per data in PTO's Assignment Data Base (copy attached).

Count 1

A method according to either of claim 27 or claim 28 of the Brown application (08/514,875)

or

a method according to claim 4 of the Fodor patent (5,800,992).

The claims of the parties are:

Brown: 1, 3-21, 27-30, 32 and 34-46

Fodor: 1-5

The claims of the parties which correspond to Count 1 are:

Brown: 27-30, 32, 34-36, 40, 43 and 45

Fodor: 4-5

The claims of the parties which do not correspond to Count 1 are:

Brown: 1, 3-21, 37-39, 41-42, 44 and 46²⁴

Fodor: 1-3

²⁴ In the opinion of the Primary Examiner, Brown claims 17-21, 38-39, 42 and 46 are not patentable.

FOOTNOTES TO PAGE 1

Appendix

Paper No. _____

Filed on behalf of: Party _____
By: Name of lead counsel, Esq.
Name of backup counsel, Esq.
Street address
City, State, and Zip-Code
Tel:
Fax:

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
(Senior Administrative Patent Judge Fred E. McKelvey)

PATRICK O. BROWN and TIDHAR D. SHALON,

Junior Party,
(Application 08/514,875),

v.

STEPHEN P. A. FODOR, DENNIS W. SOLAS
and WILLIAM J. DOWER,

Senior Party
(Patent 5,800,992).

Patent Interference No. 104,358

TITLE OF PAPER

08670418-071004

A. Summary of dates for taking action

Dates and times for taking action set in this NOTICE DECLARING INTERFERENCE are set out in **bold**. The following dates have been set in this NOTICE DECLARING INTERFERENCE:

1. **Paragraph 7:** date for identifying lead and backup counsel.
2. **Paragraph 8:** date for identifying any real party in interest.
3. **Paragraph 9:** date for requesting copies of involved and benefit applications and patents.
4. **Paragraph 17:** date and time for conference call.
5. **Paragraph 17:** date for filing list of preliminary motions to be filed.
6. **Paragraph 19:** date for accomplishing certain discovery.
7. **Paragraph 20:** date for filing clean copy of claims.
8. **Paragraph 21:** date for filing clean copy of claims in cases with drawings and/or claims containing a means plus function limitation.
9. **Paragraph 23:** dates for filing oppositions to Rule 635 motions and dates for filing replies to oppositions.
10. **Paragraph 33:** date for objecting to admissibility of evidence.
11. **Paragraph 34:** date for serving supplemental affidavits or evidence to respond to objection to admissibility of evidence.
12. **Paragraph 35:** date when cross-examination can take place.
13. **Paragraph 45:** dates for taking action with respect to settlement discussions

0867013-071004
FOOTNOTES

cc (via Federal Express):

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Legal Department
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Santa Clara, CA 95051

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Enc:

PTO Form 850 and Rule 609(b) statements

Copies of PTO PALM and Assignment Data Base material

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